REMARKS

Applicant respectfully submits that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

THE CLAIMS

REJECTION UNDER 325 USC 103

Claims 1 - 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rapport et al. (US 5,890,152), hereinafter referred to as "Rapaport". Applicant respectfully traverses this rejection and submits that the claims on file are not obvious in view of the cited references and are patentable thereover. In support of this position, Applicant submits the following arguments:

A. Legal Standards for Obviousness

The following are court opinions set the general standards in support of Applicant's position of non obviousness, with emphasis added for added clarity:

- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598* (citing *ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984))*. **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983)*, cert. denied, *469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984).* "

- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See *In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)."* Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).

- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).

- MPEP 2143.01-"The Prior Art Must Suggest The Desirability Of The Claimed Invention. There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) **(The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious**

was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation** to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

B. Brief Summary of the Present Invention

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention. As indicated by the title and throughout the patent application, **the present invention relates to a system and method for integrating on-line user ratings of businesses with search engines**," and addresses the problem facing current search engines that "use a variety of criteria to order matches to the user query and to rank the search results with higher quality search matches to **higher business satisfaction ratings**.

It is important to clarify and to reemphasize that the present invention is addressed to businesses. **A business is defined as a company or other organization that buys and sells goods, makes products, or provides services**. It is quite obvious that **a business should not be confused with, or used interchangeably with, the user of the system** (as is the case in Rapaport).

Assessing quality involves both accurately matching the user query and identifying a useful, current web page. For instance, search engines may order the matches based on what is referred to herein as "static criteria". Exemplary static criteria are the highest popularity, most recently updated, most visited, most queried, or most interconnected. It is common for users to limit the review of their search to only the first few matches of the search list." (Reference is made to page 2, line 17 through page 3, line 4 of the specification.)

The present invention also aims at providing an "adequate mechanism by which searches of business sites can be ordered based upon interactive criteria about the businesses themselves, correlating higher quality search matches to higher business satisfaction ratings. **For example, popularity, is a commonly used static criterion which is determined by the number of visits or queries of business sites, and which may depend on advertising, strategic business alliances, or creative naming of a site**, and is therefore independent of customers satisfaction with the ranked businesses. Therefore, there is still an unsatisfied need for a system and method that integrate user provided interactive criteria, such as customers and on-line users' satisfaction, with search engine results." Reference is made to page 3, lines 12-20 of the specification. Exemplary on-line sources include questionnaires and other on-line surveys obtained through other web based rating services. The business ratings assess the quality of the businesses in terms of "interactive" criteria such as customer satisfaction, professionalism, and cost and ease of use of products or services. (Reference is made to page 4, lines 6-9 of the specification.)

The business rating system integrates the ratings with the search results, and ranks and presents the integrated search results to the user based on such ratings. In this manner, the user of a search engine receives feedback from other users and/or customers about businesses of interest. (Reference is made to page 4, lines 12-14 of the specification). In a preferred embodiment, the users complete and submit on-line surveys that are integrated with the search engine results. The information provided by

the users is recorded and evaluated for the purpose of ranking the businesses. The ratings are made available to future users of the search engines. In another embodiment, in addition to a numerical rating system, the current on-line users may include descriptive annotations regarding customer satisfaction to be read by future users. In this manner, qualitative as well as quantitative feedback may be provided by the current users and examined by future users. (Reference is made to page 5, lines 5-12 of the specification.)

In use, the on-line ranking system receives users' on-line surveys or feedback, and generates ranking data for storage in the on-line ranking repository. The user profile history enables the user to update or override the rating previously provided by this user but not the ratings provided by other users. (Reference is made to page 10, lines 12-14 of the specification). The cumulative rating computation can be weighted based upon other ratings a particular user may have provided. Reference is made to page 15, lines 2-3 of the specification).

C. Rapaport et al. Patent

Rapaport describes a Personal Feedback browser and Personal Profile database for obtaining media files from the internet. The Personal Feedback browser selects media files based on user-specified information stored in the Personal Profile database. **The Personal Profile database includes Profile Objects which represent the interests, attitude/aptitude, reading comprehension and tastes of a user**. It should be emphasized that the **Profile Objects relate to the user and not to businesses.**

Profile Objects are bundles of key words/key phrases having assigned weight values. Profile Objects can be positioned a specified distance from a Self Object. The distance from the Profile Object to the Self Object represents the effect the Profile Object has in filtering and/or selecting media files for that user.

The Personal Feedback browser includes a media evaluation software program for evaluating media files based on a personal profile database. The Personal Profile database is also adjusted based upon user selection and absorption of media files. A sound-to-text software program is provided for translating a sound file to a text file.

D. Independent Claims 1, 9, 17, and 25 in Light of Rapaport

Applicant will now present arguments in support of the allowance of independent claims 1, 9, 17, and 25, and the claims dependent thereon, over Rapaport. Claim 1, as a representative claim, recites the following elements that are not described in Lang:

> "1. A system for use with a search engine to rank search results, comprising:
> an on-line ranking system for receiving any of users' **on-line surveys or feedback about businesses**;
> the on-line ranking system generating **rating data** from the any of the users' on-line surveys or feedback;
> **wherein the rating data correlates higher quality search matches to higher business satisfaction ratings;** and
> wherein the on-line ranking system **indexes the rating data**;
> an on-line ranking repository for **storing the rating data** indexed by the on-line ranking system; and
> a result sorter for **sorting query results** generated by the search engine, **based on the rating data** from the on-line ranking repository, and for generating ranked matches." (Emphasis added).

Applicant presents the following arguments, specifically in response to the office action, with respect to the representative claim 1.

OUTLINE OF ARGUMENTS

INSTANT CLAIM 1	OFFICE ACTION RE: RAPAPORT ET AL.	APPLICANT'S ARGUMENT
1. A system for use with a search engine to rank search results, comprising:	Rapaport teaches a method, system, and a computer program product for obtaining media files from the Internet by using a Personal Feedback browser and Personal Profile (abstract).	
an on-line ranking system for receiving any of users' on-line surveys or feedback **about businesses**;	Profile Builder module 211, as illustrated in FIG. 2 and 3a, subjects a user to a series of questions and interactive exercises that build a user's Personal Profile database 107 based on Profile Objects, which are used in evaluating suitability of a retrieved media file (col. 7, lines 44-58) as the step of *receiving any of users' on-line survey or feedback about businesses.*	Rapaport does not relate to businesses. Building the user's Personal Profile database to evaluate the suitability of a retrieved media file is not related to "on-line surveys or feedback about businesses".
the on-line ranking system generating rating data from the any of the users' on-line surveys or feedback;	As shown in FIG. 6a, Profile Objects contain bundles of key words and key phrases, which have corresponding signed numeric values or weights (col. 6, lines 1843) as the step of *generating rating data from the any of the user's on-line surveys or feedback.*	The numeric values or weights of the key words or key phrases are not related to surveys or feedback about businesses.
wherein the **rating data correlates higher quality search matches to higher business satisfaction ratings**; and	**Rapaport does not explicitly teach: the rating data correlates higher quality search matches to higher business satisfaction ratings.** However, as taught by Rapaport, a media file from the Internet is obtained by building a Personal Profile database containing user-specific information, then retrieving a plurality of media files from the Internet based upon a subject key word. **The plurality of media files obtained from the Internet will be evaluated based on the Personal Profile database,** (col. 3, lines 27-38). **Thus, the higher matching through the search by rating data of Personal Profile will be the higher business satisfaction rating.** Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the Rapaport method, system, and program by including the rating data matches to higher business satisfaction rating in **order to have a better result of media files from the Internet.**	(1) Applicant agrees that this important element is missing from Rapaport. (2) The evaluation of the media files based on the Personal Profile database is not related to matching to higher business satisfaction ratings. (3) The examiner is required to provide a "reason" justifying the modification of the Rapaport design. The examiner has provided a "result" of such modification but not a "reason." The modification is thus not justified. (4) Even if the foregoing modification were justified, the modified design still does not yield a design that is similar to the claimed design.
wherein the on-line ranking system indexes **the rating data;**	As shown in FIG. 13, by using Personal Feedback browser includes a Media Evaluation module 205, the content of a media file is examined in response to Personal Profile database 107 data set. The examination includes rating methods using Profile Objects containing key words and/or key phrases. The evaluation module creates a variety of indexes that assist a user in determining interest in	Rapaport does not index **rating data that correlates higher quality search matches to higher business satisfaction ratings.**

an on-line ranking repository for storing the **rating data** indexed by the on-line ranking system; and	the content of a media file (col. 10, lines 10-18) as the step of *indexing the rating data by means of an on-line ranking system.* As shown in FIG. 7A (col. 14, line 48-col. 15, line 14) is the step of storing the rating data indexed by the on-line ranking system, in an on-line ranking repository.	Rapaport does not store **rating data that** correlates higher quality search **matches to higher business satisfaction ratings.**
a result sorter for sorting query results generated by the search engine, based on **the rating data** from the on-line ranking repository, and for generating ranked matches.	In order to search a media file, Search Engine interface 109 accesses a Search Engine 125 on Internet/Intranet 114 for retrieving. Search Engine interface 109/Search Engine 125 retrieves media files based on user input. Retrieved media files are then transferred to Media Acceptance module 230 where it is determined which media files are within the user's comprehension level. Accepted files are then transferred to Media Evaluation module 205, which also receives the Search subject input data from module 207. Media Evaluation module 205 transfers rating values and file information to Search Results Interface 208 which generates a graphic display, such as display 450 in FIG. 4b, showing the media files located and also providing indicators that illustrate suitability of the media file based on the user's Personal Profile database 107. Search Engine interface 109 also transfers subject match rating of media files to media evaluation 205, which is provided by Search Engine software 125. Display 450 shows various media types including text files, audio files and video files. Indicator value Blocks in fields 411-413 contain index values that indicate the suitability of a particular media file based on a user's data set in Personal Profile database 107 and subject match rating (FIG. 15a, col. 9, lines 12-40) **as the step of sorting query results generated by the search engine, based on the rating data from the on-line ranking repository, and for generating ranked matches.**	Rapaport does not sort the query result based on the **rating data that** correlates higher quality search **matches to higher business satisfaction ratings.**

D. 1. First Missing Element

Applicant agrees with the examiner that **Rapaport does not generate rating data that correlates higher quality matches to higher business satisfaction rating**. Applicant submits that this **is an essential element/limitation** of the invention as recited in claims 1, 9, 17, and 25.

Applicant strongly reiterates that the present invention is addressed to businesses. **A business is defined as a company or other organization that buys and sells goods, makes products, or provides services**. It is quite obvious that **a business should not be confused with, or used interchangeably with, the user of the system** (as is the case in Rapaport).

It is not clear how the office action correlates the user's Profile Objects to business satisfaction rating.

D. 2. Second Missing Element

The office action refers to FIG. 6A of Rapaport, arguing that "Profile Objects contain bundles of key words and key phrases, which have corresponding signed numeric values or weights (col. 6, lines 18-43) as the step of generating rating data from the any of the user's on-line surveys or feedback."

Applicant respectfully submits that <u>the numeric values or weights of the key words or key phrases are not related to **surveys or feedback about businesses**</u>. It should be emphasized that the surveys and feedbacks relate to businesses and not to the user, as is the case in Rapaport.

As explained in the Abstract of Rapaport, "<u>Profile Objects</u> which <u>represent the interests, attitude/aptitude, reading comprehension and tastes</u> of a **user**."

Applicant respectfully requests the examiner not to equate businesses, as intended in the present application, with the user who is targeted by Rapaport.

D. 3. Third Missing Element

Applicant agrees with the Examiner that Rapaport does not explicitly teach that the rating data correlates higher quality search matches to higher business satisfaction ratings.

In order to compensate for the absence of this importance element, the Examiner essentially argued that the plurality of media files obtained from the Internet will be evaluated based on the Personal Profile database, and consequently, the higher matching through the search by rating data of Personal Profile will be the higher business satisfaction rating.

Applicant submits that the evaluation of the media files based on the Personal Profile database is not related to matching to higher business satisfaction ratings. It is not clear to Applicant how such a conclusion has been reached, and what how the Persona Profile database is equated with, or correlated to the higher business satisfaction ratings.

The examiner is required to provide a "reason" justifying the modification of the Rapaport design. The argument Rapaport could be modified by including the rating data matches to higher business satisfaction rating in order to have a better result of media files from the Internet, is akin to a "result" for such modification and not a "reason." Such a modification is thus not justified.

In addition, even if the foregoing modification were justified, the modified design still does not yield a design that is similar to the design recited in the instant claim 1.

Still, the modified design does not support a correlation to higher business satisfaction ratings, as discussed above.

D. 4. Fourth Missing Element

The Examiner argued that the evaluation module creates a variety of indexes that assist a user in determining interest in the content of a media file is analogized to the step of indexing the rating data by means of an on-line ranking system.

Applicant reiterates that "rating data" is clearly defined in claims 1, 9, 17, and 25, as rating data that correlates higher quality matches to higher business satisfaction rating, and thus the element that is missing from Rapaport impliedly reads as follows: "an on-line ranking repository for **storing the rating data** that **correlates higher quality matches to higher business satisfaction rating** and that are **indexed** by the on-line ranking system."

If, as stated by the Examiner the rating data of Rapaport does not correlate higher quality matches to higher business satisfaction rating, then, contrary to the Examiner's rejection ground, the on-line ranking repository of Rapaport cannot **store the indexed rating data that correlates higher quality matches to higher business satisfaction rating**.

D.5. Fifth Missing Element

The Examiner argued that the indicator value Blocks in fields 411-413 contain index values that indicate the suitability of a particular media file based on a user's data set in Personal Profile database 107 and subject match rating (FIG. 15a, col. 9, lines 12-40) as the step of sorting query results generated by the search engine, based on the rating data from the on-line ranking repository, and for generating ranked matches.

Applicant reiterates again (due to the importance of this point) that "rating data" is clearly defined in claims 1, 9, 17, 25 as rating data that correlates higher quality matches to higher business satisfaction rating, and thus the fourth element that is missing from Rapaport impliedly reads as follows: "a result sorter for **sorting query results** generated by the search engine, **based on the rating data** that **correlates higher quality matches to higher business satisfaction rating** from the on-line ranking repository, and for generating ranked matches."

If, as stated by the Examiner the rating data of Rapaport does not correlate higher quality matches to higher business satisfaction rating, then, contrary to the Examiner's rejection ground, the on-line ranking repository of Rapaport cannot **store the indexed rating data that correlates higher quality matches to higher business satisfaction rating**.

To conclude, independent claims 1, 9, 17, and 25 are allowable over Rapaport, and thus the claims dependent thereon are also allowable, and such allowance is respectfully requested.

E. Claims 2, 10, and 18

The Examiner has rejected claims 2, 10, and 18 based on the ground that "Rapaport further discloses including a search results transformer that converts the ranked matches to a user browsable form, (col. 10, lines 19-31)."

Applicant submits that claims 2, 10, and 18 are allowable for depending on the allowable claims 1, 9, and 17, respectively.

F. Claims 3, 11, and 19

The Examiner has rejected claims 3, 11, and 19, based on the ground that "Rapaport further discloses including an indexing engine that indexes web documents to generate indexed data, (col. 9, lines 54-61)."

Applicant submits that claims 3, 11, and 19 are allowable for depending on the allowable claims 1, 9, and 17, respectively.

G. Claims 4, 12, and 20

The Examiner has rejected claims 4, 12, and 20, based on the ground that "Rapaport further discloses including a metadata repository for storing web documents that have been downloaded on-line, (col. 19, lines 50-58)."

Applicant submits that claims 4, 12, and 20 are allowable for depending on the allowable claims 1, 9, and 17, respectively.

H. Claims 5, 13, and 21

The Examiner has rejected claims 5, 13, and 21, based on the ground that "Rapaport further discloses including a query transformer which, when prompted by a query, applies a query request to the indexed data and generates the query results, (col. 22, lines 8-15)."

Applicant submits that claims 5, 13, and 21 are allowable for depending on the allowable claims 1, 9, and 17, respectively.

I. Claims 6, 14, and 22

The Examiner has rejected claims 6, 14, and 22, based on the ground that "Rapaport further discloses wherein the any of the users' on-line surveys or feedback include annotations, (col. 14, lines 55-56)."

Applicant submits that claims 6, 14, and 22 are allowable for depending on the allowable claims 1, 9, and 17, respectively. **In addition, the cited text does not disclose the use of annotations**.

G. Claims 7, 15, and 23

The Examiner has rejected claims 7, 15, and 23, based on the ground that "Rapaport further disclose wherein the any of the users' on-line survey or feedback include any one or more of a questionnaire, a survey, or a web based rating service, (col. 14, lines 49 - 56, and col. 11-18)."

Applicant submits that claims 7, 15, and 23 are allowable for depending on the allowable claims 1, 9, and 17, respectively.

K. Claims 8, 16, and 24

The Examiner has rejected claims 8, 16, and 24, based on the ground that "Rapaport further discloses wherein the interactive criteria assess the quality of a business in terms of any one or more of: customer satisfaction, professionalism, cost, and ease of use of a product or service, (col. 11, lines 52-58)."

Applicant submits that claims 8, 16, and 24 are allowable for depending on the allowable claims 1, 9, and 17, respectively.

L. New Claims

Applicant submits that the **new claims 25-32 are allowable and do not require a new search to be** conducted by the Examiner, as they contain elements that are generally similar to those of claims 1 - 24.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,

Date: July 19, 2003

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